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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/585,386
Filing Date: July 06, 2006
Appellant(s): HOWARD ET AL.

David J. Gaskey
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed January 29, 2009 appealing from the Office action mailed April 28, 2008.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

WITHDRAWN REJECTIONS

The following grounds of rejection are not presented for review on appeal because they have been withdrawn by the examiner. The 35 U.S.C. 112 second paragraph have been withdrawn with respect to claims 1-3, 5-11, and 16-25.

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct with respect to the 35 U.S.C. 103.

(8) Evidence Relied Upon

US Patent No. 5,042,641 patented August 27, 1991 by Soldat.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later

invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-3, 5-11, and 16-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Soldat USP 5,042,641 as cited above.

See the attached marked up drawing sheet 1 of 2 depicting the claimed features.

Soldat teaches the claimed invention as outlined above except for citing the specific materials of foam, solid material, or a metallic flange. It would have been an obvious matter of design choice as to the type of material used for the insulating material/second portion. Soldat does not disclose what material his insulator 2 is made. The mere claiming of a type of known material which possesses insulating properties(all properties possess insulating material of varying degrees) is a matter of personal choice and based on the particular application at hand and the selection of one over another does not provide a patentable departure over that of Soldat.

(10) Response to Argument

RE CLAIMS 1, 16, 17

It should be noted that the mere functional recitation of "sound transmission reducing member" is clearly met by Soldat even though he does not explicitly state his brush is for that functional purpose. The fact is that any material blocking two separate areas provides some type of sound reduction whether that is the intended purpose or not. Whether the brush of Soldat is used (or stated to be used) as a sound transmission reducing member, it does provide this

function maybe not to a degree of the applicant's but nevertheless to some degree which meets the claim limitations. Furthermore, placement of the sound reducing member depends upon where the source of the noise. One could argue the bristles could be partially made of the same material as the steps (i.e. the base of the bristles) for strength and durability reasons. Claim 16 does not discuss a method of how the brush is formed, therefore the discussion involving molding a brush is moot.

RE CLAIMS 19, 21, 22

The brush of Soldat could be construed as being at the side "edge" of the step which meets the claim limitation.

The lip of Soldat 4 at its farthest right position as shown in figure 2 is "positioned relative" to the interface of his two steps as claimed in claim 21.

RE claim 22, the brush of Soldat is made of a different material as claimed and as argued by the applicant. It should be noted that claim 22 is not in any way related to the argument above for claim 17.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,
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